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W. Lawson
4/30/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ochoa, Carlos Gonzalez

Serial No.: 09/098,997

Filing Date: June 17, 1998

For: SYSTEM FOR BI-DIRECTIONAL VOICE AND DATA COMMUNICATION OVER A VIDEO DISTRIBUTION NETWORK

GAU: 2611

Examiner: Brown, Rueben M.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this paper or fee is being deposited with the United States Postal Service with sufficient postage as "First Class Mail" and is addressed to MAIL STOP AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on this 20 day of April 2004.

Carol Welch
Carol Welch

MAIL STOP AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL OFFICIAL ACTION

Dear Sir:

This communication is responsive to the Official Action mailed February 20, 2004 (the "Office Action", hereinafter). Although no fees are believed to be occasioned by virtue of filing this paper, if necessary, authorization is hereby given to charge the deposit account of the undersigned, to wit Deposit Account No. 06-0540, an amount sufficient to cover the fee for a one-month extension of time to respond. To the extent necessary, please consider this paper to be a petition for an extension of time in which to respond. If it is determined that any other fee, including additional extension of time fees, must accompany this filing, please consider this our authorization to charge deposit account of the undersigned accordingly.

INAPPROPRIATE FINAL REJECTION

At page 10 of the Office Action, the Rejection under 35 U.S.C. 102(a) the rejection of all claims was made final. Applicant believes that a final rejection was not appropriate at this time. More particularly, the MPEP 706.07(a) states in pertinent part:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

One purpose for this rule is to insure that an applicant is accorded his or her administrative due process rights. See, for example, the following statement by the C.C.P.A. in speaking of a "new" rejection by the board:

> Appellants urge that the ultimate criterion of whether a rejection is considered "new" in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection. We agree with this general proposition, for otherwise appellants could be deprived of the administrative due process rights established by 37 C.F.R. §1.196(b) of the Patent and Trademark Office. . . .

In re Kronig, 190 USPQ 425, 426-27 (C.C.P.A. 1976). The issue, before the C.C.P.A., and similarly in the present circumstance, is whether the applicant has had a "fair opportunity to react to the thrust of the rejection." Applicant believes that the situation here is analogous and that, under the circumstances, he has not had a fair opportunity to respond to the present rejection.

By way of explanation, the Examiner concedes, at page 2 of the Office Action, that "Applicant's arguments with respect to the claims have been considered but are **moot in view of the new ground(s) of rejection**." (Emphasis added). Per MPEP 706.07(a) cited *supra*, the

analysis next turns to whether the rejection was (a) caused by the applicant's amendments or (b) by the submission of an information disclosure statement. With respect to the second grounds, no new prior art was submitted and the examiner relied on previously submitted art in forming these new grounds of rejection.

With respect to (a), applicant submits that these new grounds of rejection were not caused by applicant's amendment. More particularly, note that the independent claims – Claims **17** and **30** – were amended to make specific the fact that list of permitted video channels is transmitted from the head end to a remote module within a scan line. However, this requirement has *always* been a part of Claim **22**, which recited this limitation when it was originally filed. The amendment to Claim **17** merely make explicit subject some of the subject matter that was already fully of record in a claim dependent therefrom.

As a consequence, it is believed that the instant rejection was *not* occasioned by virtue of applicant's amendments and, as such, designating the previous rejection as "Final" was inappropriate under the circumstances. Withdrawal of the instant final rejection is thus requested.